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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,724	10/08/2004	Akira Kadonaga	450100-04947	7336

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EXAMINER
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GUSHI, ROSS N

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/510,724

Applicant(s)

KADONAGA ET AL.

Examiner

Ross N. Gushi

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/17/06
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/06 has been entered.

### ***Specification***

The disclosure is objected to because of the following informalities: throughout the specification and claims and drawings, the terms "load," "loaded," and "loading portion" are used in an inconsistent, ambiguous and confusing way such that one cannot tell what is meant by these terms. The "loading portion" is identified a element 35 in the drawings however what is identified with number 35 in figure 6 seems to have little relation to what is being described as a "loading portion 35" throughout the specification and claims. Correction is required throughout.

### ***Claim Objections***

Claims 1-6 are objected to under 37 C.F.R. Rule 1.75(d)(1). The terms and the phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. In particular, the terms "load," "loaded," and "loading portion" are used in an inconsistent, ambiguous and confusing way such that one

cannot tell what is meant by these terms in the claims, specification, and drawings.

Similarly the term "host electronic equipment" seems to mean different things at different times throughout the claims and drawings. Correction is required throughout.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Throughout claims 1-6, the terms "load," "loaded," and "loading portion" are used in an inconsistent, ambiguous and confusing way such that one cannot tell what is meant by these terms in the claims, specification, and drawings. The "loading portion" is identified a element 35 in the drawings however what is identified with number 35 in figure 6 seems to have little relation to what is being described as a "loading portion 35" throughout the specification and claims. In claim 1, "a device case loaded with the host electronic equipment." What does this mean? Is the case carrying the equipment, is the case attached to the equipment, is the equipment carrying the case, or something else? "A loading portion . . . adapted to load the host electronic equipment." What does this mean? What is the loading portion? The structure identified by element 35 in the drawings is not capable of doing anything that the loading portion in the claims does. The loading portion as described in the specification is no clearer than as described in the claims. Is the loading portion carrying the equipment, is the loading portion attached to the equipment, is the

equipment carrying the loading portion, or something else? The limitations regarding the terms "load," "loaded," and "loading portion" are given little weight. Similarly the term "host electronic equipment" seems to mean different things at different times throughout the claims and drawings. In the specification, the host equipment was identified as equipment 1, but in the claims, it seems to mean something else when compared to what is being "loaded" with or by or from the "loading portion" or vice versa. The term is given little weight.

Regarding claim 5, it is ambiguous and indefinite whether applicant is claiming an erroneous insertion preventing recess portion on the adapter device, the electronic equipment, or both. The term "loading portion" makes little sense in relation to what is disclosed in the specification and drawings. The limitation is given little weight.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klatt et al. ("Klatt") in view of Kurz et al. ("Kurz"), Stahl, Best et al. ("Best"), Sandell et al. ("Sandell"), and Yao. Regarding claims 1, 5, and 6, Klatt discloses an IC card adapter 1 including a loading portion (4) "adapted to load the host electronic equipment" as claimed, a terminal portion as claimed, an opening 10 including cut portions where the opposing cut portions are different from each other. Klatt does not show insertion

orientation or attitude indicators. Stahl and Kurz disclose insertion orientation indicators (see figure 1 of Kurz and label 21 of Stahl). Best discloses a seal including various printed instructions. Sandell discloses a cartridge with orientation and attitude indicators (see figures 1 and 2 showing arrows with attitude indicators "A" and "B"). Yao discloses a card with informative indicia ("128 MB") and an orientation indicator arrow. At the time of the invention, it would have been obvious to include various instructions, information, directions, trademarks, logos, attitude, or orientation indicators, etc., on the Klatt device (on both surfaces or as desired) as taught in Stahl, Kurz, Best, Sandell, and Yao. The suggestion or motivation for doing so would have been to assist a user in orienting the device or to provide various information or instruction to the user, such motivation being well known in the art. Regarding where the indicators (such as tags or labels or imprints) would be located, whether on two or one side, or whether in the front or back of the device, the choice of location of various orientation or informative indicators would have been a matter of engineering design choice without patentable significance. Likewise the content of the informative indicia would have been a matter of engineering design choice without patentable significance.

Per claim 2, the cut portions are symmetrical.

Per claim 3, the bottom face is greater than the top face.

Per claim 4, the terminal and connecting portion are connected by a board.

### ***Response to Arguments***

Regarding claim 5, the examiner is not persuaded and maintains that throughout the claims, drawings, and specification, the terms "load," "loaded," and "loading portion"

are used in a confusing and indefinite manner. The "loading portion" is not unambiguously identifiable throughout.

Applicant's remaining arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (571) 272-2005. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at 571-272-2800 extension 33. The phone number for the Group's facsimile is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**ROSS GUSHI**  
**PRIMARY EXAMINER**

